

REMARKS

Claims 1, 3-10, 18, 19, 21, 27-29, 34, 37 and 38 are pending in this application.

Claims 1, 3-5, 7, 18, 19, 21, 27 and 29 are amended. The amendments introduce no new matter. Claims 2 and 20 are canceled without prejudice to, or disclaimer of, the subject matter recited in those claims. Reconsideration of the application based on the above amendments, and the following remarks is respectfully requested.

The Office Action, in paragraph 6, rejects claims 1-10, 18-21, 27-29, 34, 37 and 38 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Additionally, the Office Action, in paragraph 8, rejects claims 1-10, 27-29, 34 and 38 under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 1, 18, 19, 27 and 29 are amended to obviate the rejections. Specifically, the claims are amended to recite an organic functional material as is discussed beginning at at least paragraph [0012] of Applicants' disclosure.

Accordingly, reconsideration and withdrawal of the rejections of claims 1, 3-10, 18, 19, 21, 27-29. 34, 37 and 38, under 35 U.S.C. §§112, first and second paragraphs, are respectfully requested.

The Office Action, in paragraph 10, rejects claims 1, 2, 4, 5, 8, 9 and 10 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,080,450 to Cantor. Applicants respectfully traverse the rejection.

The Office Action asserts that Cantor teaches many of the features as recited in the subject matter of the pending claims. Cantor does not teach a metal deactivator with a solubility parameter in the range of 7.0 to 13.0, and in a range of 0.1 to 10 percent by weight relative to the organic functional material, as positively recited in at least claim 1, for the reasons discussed below.

0.1% of the total weight of the formulation. The subject matter of the pending claims, specifically amended claim 1, recites that "a metal deactivator . . . in a range of 0.1 to 10 percent by weight relative to an organic functional material," where the organic functional material is a single component of a liquid composition, comprising, a solute containing an organic function material, a solvent, and a metal deactivator. Therefore, based on the disclosure of Cantor, one skilled in the art would not make the assumption that the concentration as taught by Cantor, is comparable to that recited in the pending claims.

Additionally, the solubility parameter, as positively recited in the pending claims, is dependent on the formulation to which the metal deactivator is added. One skilled in the art would readily recognize that the solubility of an additive is dependent on the solvent utilized, and recognize that Cantor does not teach, nor would it have suggested, a solubility parameter in the range of 7.0-13.0.

Finally, Cantor teaches a composition comprising a 0.1% Irganox MD 1024. The Office Action asserts that since this is the same metal deactivator set forth in the Applicants' disclosure, it, therefore, inherently has the same properties as the material disclosed by the Applicants. This assertion is incorrect. MPEP §608.01(v)(I) states, "[i]f the trademark has a fixed and definite meaning, it constitutes sufficient identification unless some physical or chemical characteristics of the article or material is involved in the invention. In that event, as also in those cases where the trademark has no fixed and definite meaning, identification by scientific or other explanatory language is necessary." The MPEP also states that "[t]he relationship between a trademark and the product it identifies is sometimes indefinite, uncertain, and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark."

Applicants submit that the Examiner, in accordance with the guidance set forth in the MPEP, cannot conclusively state that the product recited in the Applicants' disclosure has

identical properties to that of a product identified by only a trade name in the applied prior art reference, without further evidence showing that the matter is necessarily present in the formulation, and that it would be so recognized by one of ordinary skill in the art. "The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robinson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). *Robinson*, further states, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.'" Applicant submits that the Office Action fails to provide evidence to affirm that the properties are identical, as asserted in the Office Action.

Claim 1 is amended to better clarify the features recited in that claim. Cantor, does not teach, nor would it have suggested, the metal deactivator recited in the pending claims.

The Office Action fails to assert a *prima facie* case of anticipation, with the applied prior art reference of Cantor, for at least the failure to show a metal deactivator with a solubility parameter in the range of 7.0 to 13.0, and in a range of 0.1 to 10 percent by weight relative to an organic functional material; and the metal deactivator containing at least one of a triazole compound and a hydrazide compound, as are positively recited in amended claim 1.

For at least the above reasons, Cantor cannot reasonably be considered to teach, or even to have suggested, the combination of all of the features recited in at least independent claim 1. Further, claims 4, 5, 8, 9 and 10 are also neither taught, nor would they have been suggested, by the Cantor for at least the respective dependence of these claims on an allowable base claim, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejection of claims 1, 4, 5, 8, 9 and 10 under 35 U.S.C. §102(b) as being anticipated by Cantor are respectfully requested.

The Office Action, in paragraph 12, rejects claims 1-6, 8-10, 18-21, 27-29, 34, 37 and 38 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,372,154 to Li (hereinafter "Li"). Applicants respectfully traverse the rejection.

The Office Action asserts that Li teaches the functional additives (such as triazoles) are added in an amount of 0.5-40 percent by weight, and that it would have been obvious to one of ordinary skill in the art at the time of the invention to have selected any triazole derivative because Li generally teaches triazoles are suitable as a functional additive for the device. This assertion is incorrect on two grounds, as discussed below.

First, as discussed previously, with respect to the 35 U.S.C. §102(b) rejection, the subject matter of the pending claims, specifically amended claims 1, 18, 19, 27 and 29 recites that "a metal deactivator . . . in a range of 0.1 to 10 percent by weight relative to an organic functional material," where the organic functional material is a single component of a liquid composition, comprising, a solute containing an organic functional material, a solvent, and a metal deactivator. Therefore, based on the disclosure of Li, one skilled in the art would not make the assumption that the concentrations as taught by Li, were comparable to those as recited in the subject matter of the pending claims.

Second, the Examiner asserts that Li teaches functional additives (such as triazoles) are added in an amount of 0.5-40 percent by weight. The Examiner's specific reference (col. 2, lines 44-62) refers to functional additives that are utilized in lowering the viscosity and are not specifically identified as metal deactivators. The Examiner's conclusory statement is not sufficient to establish a *prima facie* case of obviousness with respect to the asserted prior art reference of Li. One of ordinary skill in the art would recognize that varying concentrations of a functional additive will result in different properties being presented in, or by, the final formulation. As such, without positively identifying the particular use of the additive (metal

formulation. As such, without positively identifying the particular use of the additive (metal deactivator versus lowering the viscosity), it is over-reaching to assume a different use based on the properties of a given concentration for another use.

For at least the above reasons, Li cannot reasonably be considered to teach, or to have suggested, the combinations of all of the features recited in at least independent claims 1, 18, 19, 27 and 29. Further, claims 3-6, 8-10, 21, 28, 34, 37 and 38 would also not have been suggested by the applied prior art references for at least the respective dependence of these claims on allowable base claims, as well as for the separately patentable subject matter that each of these claims recites.

Accordingly, reconsideration and withdrawal of the rejections of claims 1, 3-6, 8-10, 18, 19, 21, 27-29, 34, 37 and 38 under 35 U.S.C. §103(a) as being unpatentable over Li are respectfully requested.

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 3-10, 18, 19, 21, 27-29, 34 and 37 and 38 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,


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